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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,855	10/13/2000	Chaitan Khosla	286002021100	6952
25225	7590	09/27/2004		
MORRISON & FOERSTER LLP 3811 VALLEY CENTRE DRIVE SUITE 500 SAN DIEGO, CA 92130-2332				
EXAMINER KERR, KATHLEEN M				
ART UNIT		PAPER NUMBER		
1652				

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/687,855

**Applicant(s)**

KHOSLA ET AL.

**Examiner**

Kathleen M Kerr

**Art Unit**

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 July 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61,63-69,71-74 and 78-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 61,63-69,71-74,78,80,81 and 83 is/are allowed.
- 6) ☒ Claim(s) 79 and 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Application Status***

1. In response to the previous Office action on the merits, a non-Final rejection (mailed on April 21, 2004), Applicants filed an amendment and response received on July 23, 2004. Said amendment cancelled Claims 1, 55, 56, 58-60, and 75-77 and amended Claims 69, 80, and 83. Thus, Claims 61, 63-69, 71-74, and 78-83 are pending in the instant Office action.

### ***Original Restriction/Rejoinder***

2. The restriction of original claims was set forth in the Restriction Requirement mailed January 24, 2002; said restriction was a 5-way restriction wherein Group I, product claims, were elected and examined. Said products are now considered allowable. Groups II and III are drawn to methods of making or using the now allowable products; Group IV is drawn to different products and Group V is drawn to methods of using said different products.

3. Claims 61 and 69 are directed to allowable products herein. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 78-83, directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 78-83 are hereby rejoined and fully examined for patentability under 37 C.F.R. § 1.104.

In accordance with the Official Gazette notice, *supra*, original process claims 40-41, which do not depend from or otherwise include all the limitations of the allowable product, have NOT been rejoined.

The restriction of Groups I, II, and III is herein withdrawn. The restriction of Groups I-III from Group IV and Group V is maintained.

***Priority***

4. As previously noted, the instant application is granted the benefit of priority for the U.S. Provisional Application Nos. 60/159,090 filed on October 13, 1999, 60/206,082 filed on May 18, 2000 and 60/232,379 filed on September 14, 2000.

***Withdrawn - Claim Rejections - 35 U.S.C. § 112***

5. Previous rejection of Claim 58 under 35 U.S.C. § 112, first paragraph, new matter, is withdrawn by virtue of Applicant's cancellation of said claim.

6. Previous rejection of Claims 1, 55, 58-60, and 69-74 under 35 U.S.C. § 112, first paragraph, written description, is withdrawn by virtue of Applicant's amendment limiting the claims to host cells with sfp from *B. subtilis* as the phosphopantetheinyl transferase.

***Withdrawn - Claim Rejections - 35 U.S.C. § 103***

7. Previous rejection of Claims 1, 55, 56, 59, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Santi *et al.* (USPAP 2002/0142401) and Barr *et al.* (WO 98/27203) is withdrawn by virtue of Applicant's cancellation of said claims.

## **NEW ISSUES**

### ***Objections to the Specification***

8. The specification is objected to because the title is not descriptive. A new title is required that is clearly indicative of the invention to which the elected claims are drawn (see M.P.E.P. § 606.01). The Examiner suggests the following new title:

---*E. coli* and *Streptomyces* Host Cells that Contain MatBC Genes Useful for Enhanced Polyketide Production---

### ***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 79 and 82 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The nature of “polyketide synthase genes according to claim 61” is unclear; said claim does not refer to PKS genes whatsoever. And the analogous reference in Claim 82 is also unclear as to what limitations claim 69 imparts of the PKS genes in Claim 82. Clarification is required.

*Summary of Pending Issues*

10. The following is a summary of the issues pending in the instant application:
- a) The specification stands objected to because the title is not descriptive.
  - b) Claims 79 and 82 stand rejected under 35 U.S.C. § 112, second paragraph.

*Conclusion*

11. Claims 61, 63-69, 71-74, 78, 80, 81, and 83 are allowable (see allowable subject matter section in previous Office action). Claims 79 and 82 are rejected for the reasons identified in the numbered sections of this Office action. Applicants must respond to the objections/rejections in each of the numbered sections in this Office action to be fully responsive in prosecution.

The instant Office action is **NON-FINAL** based on the new grounds of rejection on method claims required after rejoinder of methods claims herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (571) 272-0931. The examiner can normally be reached on Monday through Friday, from 9:00am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1652

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen M Kerr  
Primary Examiner  
Art Unit 1652

September 21, 2004